REMARKS

In this final Office Action, The Examiner noted 1-16 were pending and rejected claims 1-16. By this response, claims 1-16 are cancelled without prejudice or disclaimer and new claims 17-24 are added. The new claims are fully supported by Applicants' original specification, including the original claims and drawings. Arguments addressing the Examiner's position are provided. In view of both the amendments presented above and the following discussion, Applicants submit that none of the claims now pending in the application are anticipated or obvious under the provisions of 35 U.S.C. §102 and 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

REJECTION OF CLAIMS UNDER 35 U.S.C. §102

Claims 1-4, 6-8, 15, and 16

The Examiner has rejected claims 1-4, 6-8, 15, and 16 under 35 U.S.C. §102(e) as being anticipated by Rao (U.S. Patent 5,940,738, hereinafter "Rao"). Applicants respectfully traverse the rejection, because claims 1-4, 6-8, 15, and 16 are cancelled. Applicants respectfully request consideration of new claims 17-24.

Applicants' independent claim 17 recites (emphasis added):

> 17. (New) A system, comprising:
> a transport stream generator for generating and providing at least one transport stream to a plurality of terminals, the transport stream including an interactive program guide (IPG), the IPG including a plurality of video segments, the video segments including a set of frequently accessed video segments that are broadcast continuously and a set of less frequently accessed video segments that are demand-cast; and
> a session manager for managing delivery of the IPG and for monitoring demand-cast stream usage by the terminals, and for

> requesting that the transport stream generator insert one of the less frequently accessed video segments into the transport stream, upon request from one of the terminals and based on the demand-cast stream usage.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). The Rao reference fails to disclose each and every element of the claimed invention, as arranged in the claim.

Specifically, the Rao reference fails to disclose an IPG that includes a set of frequently accessed video segments that are broadcast continuously and a set of less frequently accessed video segments that are demand-cast, as claimed. By contrast, the Rao reference discloses an "opportunistic service" that fills capacity left unused by current subscriber activity so that a bandwidth constrained access line can provide NVOD with this "opportunistic bandwidth scheme". (See Rao, abstract, col. 3, line 65 to col. 4, line 8; col. 17, lines 38-43.) In addition, Rao merely discloses an Electronic Program Guide (EPG) that each user uses to select a desired channel for viewing. (See Rao, col. 16, lines 1-3.) Thus, in Rao the user can only select a channel, which may be an NVOD channel or other broadcast channels, because the Rao reference is merely about "the concept of extending the tuning upstream into the network" or "shifting tuning into the network". (See Rao, col. 13, lines 39-40; col. 14, lines 21-22; col. 15, line 64 to col. 16, line 3.) The user cannot select among two sets of video segments in an IPG, as claimed. There is no teaching in Rao of the claimed IPG that includes a set of frequently accessed video segments that are broadcast continuously and a set of less frequently accessed video segments that are demand-cast.

Therefore, the Rao reference fails to teach each and every element of the claimed invention, as arranged in the claim.

As such, Applicants submit that independent claim 17 is not anticipated and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder. Furthermore, claims 18-24 depend, either directly or indirectly, from independent claim

17 and recite additional features thereof. As such and at least for the same reasons as discussed above, Applicants submit that these dependent claims are also not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

REJECTION OF CLAIMS UNDER 35 U.S.C. §103

Claim 5

The Examiner has rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Rao in view of Hendricks et al. (U.S. Patent No. 5,559,549, hereinafter "Hendricks"). Applicants respectfully traverse the rejection, because claim 5 is cancelled. Applicants respectfully request consideration of new claims 17-24.

Applicants' explanation of Rao with respect to the §102 rejection is also applicable with respect to the §103 rejection herein. As such, and for brevity, that explanation will not be repeated in as great detail. As indicated, Rao does not teach or suggest an IPG that includes a set of frequently accessed video segments that are broadcast continuously and a set of less frequently accessed video segments that are demand-cast, as claimed. Rather, the Rao reference merely discloses the concept of extending the tuning of a channel upstream into the network.

The addition of Hendricks does not correct the deficiencies of Rao. Hendricks discloses a digital television program delivery system that provides subscribers with a menu-driven access to an expanded television program package. Hendricks discloses program overlay menus. (See Hendricks, col. 18, lines 11-27.) However, Hendricks is silent with respect to an IPG that includes a set of frequently accessed video segments that are broadcast continuously and a set of less frequently accessed video segments that are demand-cast, as claimed.

For prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. §103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). Moreover, the mere

fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Nowhere in the combination of references is there any teaching, suggestion, or incentive to include "said transport stream generator maintaining status of streams being served." Therefore, the combination of Rao and Hendricks fails to teach or suggest Applicants' invention as a whole.

As such, Applicants submit that claims 17-24 are not obvious and fully satisfies the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

Claims 9-14

The Examiner has rejected claims 9-14 under 35 U.S.C. §103(a) as being unpatentable over Rao in view of Aharoni et al. (U.S. Patent 6,014,694, hereinafter "Aharoni"). Applicants respectfully traverse the rejection, because claims 9-14 are cancelled. Applicants respectfully request consideration of new claims 17-24.

Applicants' explanation of Rao with respect to the §102 rejection is also applicable in this section. As such, and for brevity, those comments will not be repeated. The addition of Aharoni does not correct the deficiencies of Rao. Aharoni discloses transporting video over networks wherein the available bandwidth varies with time. However, Aharoni is also silent with respect to an IPG that includes a set of frequently accessed video segments that are broadcast continuously and a set of less frequently accessed video segments that are demand-cast, as claimed.

Therefore, the combined references fail to teach Applicants' invention as a whole. As indicated above, Rao or Aharoni do not render Applicants' claim 17 obvious. In addition Applicants' claims 18-24 depend (either directly or indirectly) from claim 17 and recite additional features therefore. As such, Applicants submit that claims 17-24 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejection be withdrawn.

SECONDARY REFERENCES

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to Applicants' disclosure than the primary references cited in the Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

CONCLUSION

Thus, Applicants submit that none of the claims, presently in the application, are anticipated or obvious under the respective provisions of 35 U.S.C. §§102 and 103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Lea Nicholson or Eamon Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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